



1713

PATENT
Attorney Docket No. 5725.0849
Application No. 09/809,007
Custom r No. 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jean-Marc ASCIONE et al.

Application No.: 09/809,007

Filed: March 16, 2001

For: STABILIZING COMPOSITIONS
COMPRISING AT LEAST TWO
ANIONIC ASSOCIATIVE POLYMERS,
THEIR USE FOR STABILIZATION OF
NON-SOLID COMPOSITIONS, AND
COMPOSITIONS COMPRISING AT
LEAST ONE STABILIZING
COMPOSITION

Group Art Unit: 1713

Examiner: Harlan, Robert D.

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10/22/03

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TC 1700

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY UNDER 37 C.F.R. § 1.111

In response to the Office Action dated July 15, 2003, Applicants respectfully request reconsideration of this application in view of the following remarks.

I. Status of the Claims

Claims 1-76 are pending in this application. Claims 19-54 and 73-76 have been withdrawn from consideration by the Examiner. In the present Office Action, the Examiner asserts that "[c]laims 1-18 and 55-75 are allowed."¹ See page 3 of the

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¹ Applicants note that claims 73-76 were withdrawn from consideration by the Examiner.

present Office Action. However, it also appears that “[c]laims 8, 14, 61, and 67 are rejected under 35 U.S.C. 112, second paragraph....” See page 2 of the present Office Action (reciting “The Examiner maintains the rejection....”). Accordingly, Applicants respectfully request clarification.

Nonetheless, in order to be fully responsive, Applicants submit this Reply to address the Examiner’s remarks with respect to claims 8, 14, 61, and 67.

Applicants also acknowledge with appreciation the Examiner’s withdrawal of the previous rejection under 35 U.S.C. §102(b).

II. Rejection under § 112, second paragraph

Claims 8, 14, 61, and 67 appear to have been rejected under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention.

A. *Claims 14 and 67*

With respect to claims 14 and 67, the Examiner asserts that he “maintains the rejection [and] suggests that the Applicants replace ‘Beheneth-25’ with -- polyethylene glycol ether of behenyl alcohol.--” See pages 2-3 of the present Office Action. Applicants respectfully decline to do so for at least the following reasons.

First, as recited in M.P.E.P. § 2173, “the primary purpose of [the] requirement of definiteness of claim language is to ensure that the scope of the claims is clear so that the public is informed of the boundaries of what constitutes infringement of

the patent.” In the present case, one of ordinary skill in the art would know what compound “beheneth-25” referred to and even if, *arguendo*, they did not know the exact compound, it is clearly defined in the International Cosmetic Ingredient Dictionary and Handbook, Seventh Edition, 1997, Vol. 1, at page 122 (copy previously submitted), which is accessible to the public.

“A secondary purpose [of the requirement of definiteness of claim language] is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention.” See M.P.E.P. § 2173. In the present case, the Examiner has raised no objections to the rejected claims under 35 U.S.C. 112, first paragraph, and has, in fact, indicated claims 1-18 and 55-75 are allowed.” See page 3 of the present Office Action. Accordingly, Applicants see no reason to amend the present claims as suggested by the Examiner. Nor, in fact, has the Examiner provided such a reason, despite accepting the fact that “beheneth-25” is not a trademark.

Applicants respectfully remind the Examiner of the instructions set forth in the M.P.E.P. 2173.02:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, **not whether more suitable language or modes of expression are available**. When the examiner is satisfied that patentable subject matter is disclosed, and it is

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apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.

See M.P.E.P. § 2173.02 (emphasis added). In the present case, the Examiner is, apparently, satisfied that patentable subject matter is disclosed and that the claims are directed to such patentable subject matter, as “[c]laims 1-18 and 55-75 are allowed.” See page 3 of the present Office Action.

Therefore, according to the M.P.E.P., the Examiner should allow claims as they define the patentable subject matter with a reasonable degree of particularity and distinctness. In fact, the phrase “polyethylene glycol ether of behenyl alcohol” proposed by the Examiner is not synonymous with “beheneth-25.” Moreover, in addition to the presently claimed beheneth-25, there exist other polyethylene glycol ethers of behenyl alcohol such as beheneth-5, beheneth-10, beheneth-20, and beheneth-30. See e.g., International Cosmetic Ingredient Dictionary and Handbook, Seventh Edition, 1997, Vol. 1, page 122 (copy previously submitted, showing beheneth-25 and beheneth-30). Accordingly, the proposed amendment would not even reflect the subject matter, which Applicants are trying to claim in rejected claims 14 and 67 as accurately as does the word “beheneth-25.”

For at least the foregoing reasons, Applicants request that the rejection of claims 14 and 67 be withdrawn.

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B. Claims 8 and 61

With respect to the rejection of claims 8 and 61 under § 112, second paragraph, regarding the term "Acrylates/C10-30 Alkyl Acrylate Crosspolymer," the Examiner asks: "What does the '/' and 'crosspolymer' mean?" See page 3 of the present Office Action.

First, the symbol "/" is always used in co- or terpolymer nomenclature and separates the various monomers from which the copolymer or terpolymer is formed. For example, "A/B Copolymer" would mean a copolymer formed from A monomers and B monomers. This is basic knowledge for one of ordinary skill in the art.

Second, the term "crosspolymer" refers to crosslinked polymers, copolymers or terpolymers. Again, one of ordinary skill in the art would know the meaning of this term.

To further support their position that the terminology used to describe the presently claimed polymers is well-known and accurate terminology, Applicants submit herewith a definition of "Acrylates/C10-30 Alkyl Acrylate Crosspolymer." See International Cosmetic Ingredient Dictionary and Handbook, Ninth Edition, 2002, Vol. 1, page 29.

For at least the foregoing reasons, Applicants request that the rejection of claims 8 and 61 be withdrawn.

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III. Rejoinder of Claims

In the Restriction Requirement dated October 7, 2002, the Examiner required restriction under 35 U.S.C. § 121 between the following groups of claims: Group I comprising claims 1-18 and 55-72 drawn to compositions, Group II comprising claims 19-54 drawn to methods for using the compositions of Group I, and Group III comprising claims 73-76 drawn to a kit comprising the compositions of Group I. Applicants elected, with traverse, the invention of Group I, i.e., claims 1-18 and 55-72 drawn to compositions.

"[I]f applicant elects claims direct to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." See M.P.E.P. § 821.04. In the present case, withdrawn claims 19-54 and 73-76 include all the limitation of the compositions of claims 1-18 and 55-72. For example, independent method claim 19 includes the limitations of claims 1 and 2, and dependent claims 20-35 include the limitations of claims 3-18, respectively. Similarly, independent method claim 36 includes the limitations of claims 1 and 2, and dependent claims 37-54 include the limitations of claims 3-18, respectively. Claims 73-76 also include limitations of claims in Group I.

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Accordingly, should the Examiner again find the subject matter of claims 1-18 and 55-72 allowable, Applicants respectfully request rejoinder of claims 19-54 and 73-76.

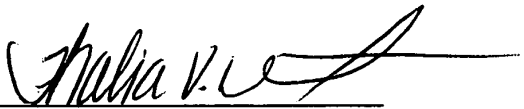
IV. Conclusion

Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extension of time under 37 C.F.R. § 1.136 required to enter this response and charge those additional fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P

By: 
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Dated: October 15, 2003

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International Cosmetic Ingredient Dictionary and Handbook

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Volume 1

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acrylic acid and Beheneth-25 (q.v.) and one or more monomers of acrylic acid, methacrylic acid, or one of their simple esters.

Chemical Class: Synthetic Polymers

Function: Viscosity Increasing Agent - Aqueous

Trade Name:

Aculyn 28 Polymer (Rohm and Haas)

ACRYLATES/BEHENYL ACRYLATE/ DIMETHICONE METHACRYLATE COPOLYMER

Definition: Acrylates/Behenyl Acrylate/Dimethicone Methacrylate Copolymer is a copolymer of behenyl acrylate, dimethicone methacrylate and one or more monomers of acrylic acid, methacrylic acid or one of their simple esters.

Chemical Classes: Siloxanes and Silanes; Synthetic Polymers

Function: Skin-Conditioning Agent - Miscellaneous

Trade Name:

KP-562 (Shin Etsu)

ACRYLATES/t-BUTYLACRYLAMIDE COPOLYMER

Definition: Acrylates/t-Butylacrylamide Copolymer is a copolymer of tert-butyl acrylamide and one or more monomers of acrylic acid, methacrylic acid, or one of their simple esters.

Chemical Class: Synthetic Polymers

Functions: Binder; Film Former; Hair Fixative

Trade Names:

Ultrahold 8 (BASF)

Ultrahold Strong (BASF)

ACRYLATES/C10-30 ALKYL ACRYLATE CROSSPOLYMER

Definition: Acrylates/C10-30 Alkyl Acrylate Crosspolymer is a copolymer of C10-30 alkyl acrylates and one or more monomers of acrylic acid, methacrylic acid or one of their simple esters crosslinked with an allyl ether of sucrose or an allyl ether of pentaerythritol.

Chemical Class: Synthetic Polymers

Functions: Emulsion Stabilizer; Viscosity Increasing Agent - Aqueous; Viscosity Increasing Agent - Nonaqueous

Reported Product Categories: Moisturizing Preparations; Cleansing Products (Cold Creams, Cleansing Lotions, Liquids and Pads); Face and Neck Preparations (Excluding Shaving Preparations); Hair Shampoos (Coloring); Body and Hand Preparations (Excluding Shaving Preparations); Bath Preparations, Misc.; Fragrance Preparations, Misc.; Skin Care Preparations, Misc.; Powders (Dusting and Talcum, Excluding Aftershave Talcs); Shampoos (Non-coloring); Aftershave Lotions; Eye Makeup Removers; Indoor Tanning Preparations; Eyeliners; Perfumes; Personal Cleanliness Products, Misc.; Suntan Gels, Creams, and Liquids; Suntan Preparations, Misc.

Trade Names:

Carbopol 1342 (BF Goodrich)
Carbopol 1382 (BF Goodrich)
Carbopol ETD 2020 (BF Goodrich)
Pemulen TR-1 (BF Goodrich)
Pemulen TR-2 (BF Goodrich)

Trade Name Mixtures:

Aloe Vera Gel - Thickened "CG" (Terry)
Magilyne (Greentech)
Nucleolys (Greentech)
Polyphenols de cacao (Greentech)
Pongamia Complex (Greentech)
Protelin L (Greentech)
Retimine (Greentech)
Self Tanning Complex (Greentech)
The Vert Encapsule (Greentech)

ACRYLATES/CARBAMATE COPOLYMER

Definition: Acrylates/Carbamate Copolymer is a copolymer of carbamate and one or more monomers of acrylic acid, methacrylic acid or one of their simple esters.

Chemical Class: Synthetic Polymers

Functions: Hair Conditioning Agent; Skin-Conditioning Agent - Miscellaneous

Trade Name:

Chronosphere MT (Brooks)

Trade Name Mixtures:

Chronosphere Biopol OE (Brooks)
Chronosphere FHC/HA Blend (Brooks)
Chronosphere /G (Brooks)
Chronosphere Glycolic Acid (Brooks)
Chronosphere Hyaluronic (Brooks)
Chronosphere MCX (Brooks)
Chronosphere Rosemary Extract (Brooks)
Chronosphere SOD (Brooks)

ACRYLATES/CETETH-20 ITACONATE COPOLYMER

Definition: Acrylates/Ceteth-20 Itaconate Copolymer is a copolymer formed from the half

ester of itaconic acid and Ceteth-20 (q.v.) and one or more monomers of acrylic acid, methacrylic acid or one of their simple esters.

Chemical Class: Synthetic Polymers

Function: Viscosity Increasing Agent - Aqueous

Trade Name:

Structure 3001 (National Starch)

ACRYLATES/CETETH-20 METHACRYLATE COPOLYMER

Definition: Acrylates/Ceteth-20 Methacrylate Copolymer is a copolymer formed from the ester of methacrylic acid and Ceteth-20 (q.v.), and one or more monomers consisting of acrylic acid, methacrylic acid or one of their simple esters.

Chemical Class: Synthetic Polymers

Function: Viscosity Increasing Agent - Aqueous

ACRYLATES COPOLYMER

CAS No.: 25035-69-2

Definition: Acrylates Copolymer is a copolymer of two or more monomers consisting of acrylic acid, methacrylic acid or one of their simple esters.

Information Sources: 21CFR175.105, 21CFR175.210, 21CFR175.300, 21CFR175.320, 21CFR176.170, 21CFR176.180, 21CFR177.1010, 21CFR178.3790, CIR: [SQ], JCIC, JCLS, JSQI, TSCA

Chemical Class: Synthetic Polymers

Functions: Adhesive; Binder; Film Former; Hair Fixative; Suspending Agent - Nonsurfactant

Reported Product Categories: Lipsticks; Face Powders; Blushers (All types); Basecoats and Undercoats; Manicuring Preparations, Misc.; Hair Dyes and Colors (All Types Requiring Caution Statements and Patch Tests); Eye Makeup Preparations, Misc.; Makeup Preparations (Not eye), Misc.; Eye Shadows; Mascara; Powders (Dusting and Talcum, Excluding Aftershave Talcs); Cleansing Products (Cold Creams, Cleansing Lotions, Liquids and Pads); Eyeliners; Foundations; Hair Sprays (Aerosol Fixatives); Moisturizing Preparations; Skin Care Preparations, Misc.; Hair Bleaches; Paste Masks (Mud Packs); Deodorants (Underarm); Makeup Bases; Nail Polish and Enamels

The inclusion of any compound in the *Dictionary and Handbook* does not indicate that use of that substance as a cosmetic ingredient complies with the laws and regulations governing such use in the United States or any other country.